



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/822,295 | 04/02/2001 | Bahija Jallal | 038602/1125 | 8862 |

7590 01/20/2004
Beth A. Burrous
FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, DC 20007-5109

EXAMINER

HOLLERAN, ANNE L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1642 | |

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/822,295

Applicant(s)

JALLAL ET AL.

Examiner

Anne Holleran

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragraph, lack of enablement.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 12 and 23-34.


Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendment introduces new matter into the specification because the proposed claims would be drawn to polypeptides comprising fragments of a PTP04 polypeptide that do not have enzymatic activity (e.g. comprising amino acid sequence 1-48 or amino acid sequence 295-807 of SEQ ID NO: 2) that are comprised within polypeptides that do have an enzymatic activity of a tyrosine phosphatase. Therefore, the claims read on fragments of a PTP04 polypeptide fused with a non-PTP04 polypeptide fragment having any type of tyrosine phosphatase activity. The specification has not defined a genus of PTP04 polypeptides that contain non-PTP04 polypeptide phosphatase catalytic domains, and further, the specification has not defined a genus of PTP04 polypeptides containing non-PTP04 polypeptide phosphatase catalytic domains by way of any teaching of what constitutes the common structural features of such a genus. The proposed amendment of claim 32 introduces new matter for the reasons set forth above with respect to claim 12. This is because the specification only teaches SEQ ID NOS: 15, 16 or 17 as examples of peptides to be used in making antibodies specific for a polypeptide comprising SEQ ID NO: 2, and does not contemplate any polypeptide other than SEQ ID NO: 2 itself that comprises the sequences and also possesses an enzymatic activity of tyrosine phosphatase.

The proposed amendment fails to address 112, second paragraph rejection of the claims with respect to claim 12, subsection "d", because this was not amended in the same way that subsection "b" was amended to delete the "full length".

The proposed amendment fails to obviate the rejections of the claims under 102(a), 102(b) and 102(e). With respect to the rejection over Q93095 (rejection #5, 102(a)), this rejection would be maintained for two reasons. One is that section "d" was not amended in the same manner as section "b", making it unclear what is meant by the limitation of having 90% or 95% identity to full length of SEQ ID NO: 2. The second reason is that amino acid identity may be over any part of an amino acid sequence if the claim lacks a recitation of what part of the sequence is to be compared with the prior art. Thus, Q93095, which teaches a polypeptide that comprises amino acids 164-243 of SEQ ID NO: 2 satisfies the limitations of section "b" because it is a sequence that lacks amino acid residues 1-48 or 295-807, and it has at least 90 or 95 percent identity to a part of SEQ ID NO: 2. The same analysis would be applied to the teachings of Matthews (rejection #6, 102(b)), which teaches a polypeptide that comprises amino acids 89-120 of SEQ ID NO: 2; and would be applied to the teachings of Cheng (rejection #7, 102(e)), which teaches a polypeptide that comprises amino acids 790-802 of SEQ ID NO: 2.


ANTHONY G. CARINA
SUPERVISING PATENT EXAMINER
TECHNOLOGY CENTER 1000